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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/186,064	11/04/1998	THOMAS N. TOOMBS	HARI.127US0	1357

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SKJERVEN MORRILL MACPHERSON LLP
THREE EMBARCADERO CENTER
28TH FLOOR
SAN FRANCISCO, CA 94111

EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 03/01/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/186,064

Applicant(s)

TOOMBS ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/22/02 have been fully considered but they are not persuasive.

Applicants arguments with respect to the essential material being in figures 1, 2 and 3 and not just the MultiMediaCard System specification: The examiner notes the essential material that the applicants have repeatedly argued as the feature that makes the claims patentable is the card selecting the communication protocol that corresponds to the protocol of the master as opposed to the master telling the card which protocol to use. This feature which the examiner notes is very well known is not the mere connection to the bus that the applicants are now pointing to in the figures. Since the applicants have argued that this well known feature (the card selecting the communication protocol that corresponds to the protocol of the master) is the feature that provides patentable distinction over Iijima, it must be shown in the drawings. Since it is not shown in the drawings the drawings are not in compliance with 37 CFR 1.83(a).

In response to applicants argument that support for this well known feature which the applicants argue make the claim language patentable distinct from Iijima in found in "the MultiMediaCard System specification" incorporated by reference. The attempt to incorporate subject matter into this application by reference to the feature of the card selecting the communications protocol that corresponds to the protocol of the master as opposed to the master telling the card which protocol to use is improper because according to the applicants this is the patentable distinction over Iijima thus essential.

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In response to applicants statement that in the previous amendment the applicants explicitly challenged the official notice: This is clearly incorrect. Applicants merely noted that the examiner took official notice and argues that the obviousness rejection was improper because no supporting evidence was provided. The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that "it is common practice to postheat a weld after the welding operation is completed" and that "it is old to adjust the intensity of a flame in accordance with the heat requirements."). See also In re Seifreid, 407 F.2d 897, 160 USPQ 804 (CCPA 1969) (Examiner's statement that polyethylene terephthalate films are commonly known to be shrinkable is a statement of common knowledge in the art, supported by the references of record.).

The examiner also notes that at the time the examiner also explicitly provided the Users Manual for the SupraExpress 288 and the SupraExpress 288i PnP as support for this well known feature.

In response to applicants noting that "there must be some teaching, reason, suggestion or motivation to combine existing elements": The examiner notes the applicants failed to include the rest of the quote. So the examiner will finish it for the applicant "to produce the claimed device, *it is not necessary that the cited references or prior art specifically suggest the combination.*" Emphasis added. Since a motivation was provided, specifically that of providing

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backwards compatibility the rejection was proper. The examiner notes another acceptable motivation is that of reducing handshaking steps.

In regards to applicants remarks concerning the grouping of the new claims with already rejected claims. Grouping of claims is proper. The examiner further notes in the previous action claim 66 was grouped with now canceled claim 1 and the limitation for which the obviousness rejection was required is not included in claim 66, thus claim 66 could just as easily be rejected under a 35 U.S.C 102 rejection as opposed to the 103 rejection in which it was grouped. The 103 rejection to claim 66 will be maintained.

In regards to applicants remarks concerning Iijima being a single reference 35 USC 103 rejection. Single reference 103 rejections are proper. The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that "it is common practice to postheat a weld after the welding operation is completed" and that "it is old to adjust the intensity of a flame in accordance with the heat requirements."). See also In re Seifreid, 407 F.2d 897, 160 USPQ 804 (CCPA 1969) (Examiner's statement that polyethylene terephthalate films are commonly known to be shrinkable is a statement of common knowledge in the art, supported by the references of record.).

In regards to applicants argument that Iijima teaches that the external master designates the protocol that the IC card is to use to communicate to the master instead of the claim language of the card selecting the protocol to communicate based upon the communication protocol of the

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master. First the examiner notes that this difference is only one of where in the system the selection is made. Second the examiner took Official notice that the card doing the selection as opposed to the master making the selection was notoriously well known. Third the examiner cited a reference that taught this well known feature. Fourth the applicants have not provided support for this feature in the specification. Fifth if Iijima taught this feature, Iijima would be a 102 reference as opposed to 103 which the examiner applied.

In regards to applicants argument that Iijima only teaches one IC card. The examiner notes Iijima teaches that IC cards (plural) exchange data. Iijima however only describes the use of one card. The examiner notes MPEP 2144.04 VI B. indicates duplication of parts has no patentable significance unless a new and unexpected result is produced. In this case there is no unexpected result.

In regards to applicants argument that applicants use a select signal to select which card to communicate to. Official notice is taken that the use of a select signal to select which card to communicate to is so notoriously well known as to be trivial. The examiner also notes in the rejection the examiner pointed to the SPI protocol which uses this select signal. The examiner further notes the applicants have already admitted the SPI protocol is prior art.

In regards to applicants argument regarding the typographical error in the rejection in which the examiner merged two separate sentences. The examiner apologizes for his dyslexia. It should have read "Iijima does not teach a distinct bus for each of the plug-in cards. Mote teaches two separate busses one for standard parallel communication and one for serial JTAG (error handling protocol) communication."

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In regards to applicants argument that Mote is directed to testing a bus structure and not for a host communication with one or more cards. The purpose of Motes invention is immaterial to the teaching of Mote that of two different communication protocols communicating to a card via two separate busses.

In regards to applicant argument that New claim 86 adds the limitation that the card selects in response to initialization when connected to the host. The examiner notes this feature was already treated in Iijima in which the protocol is selected after a reset (initialization) and this claim will properly be grouped with the like claims.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

"Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection." *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard* 319 F.2d 194, 138 USPQ 148 (CCPA 1963).

"Furthermore, artisans must be presumed to know something about the art apart from what the references disclose." *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

"The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

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"Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein." *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

The test of obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ 2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ 2d 1500, 1502 (Fed. Cir. 1988).

"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

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"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference."

Entire quote from *In re Oetiker*, 24 USPQ 2d 1443 (CAFC 1992).

Accordingly, it is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings would suggest to one of ordinary skill in the art, not what the art specifically suggests.

Specification

2. The attempt to incorporate subject matter into this application by reference to the feature of the card selecting the communication protocol that corresponds to the master as opposed to the master telling the card which protocol to use is improper because according to the applicants argument this is the feature that makes the claim language allowable over the prior art and its support is in the MultiMediaCard System specification.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the memory card selecting the protocol to use must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 66-68, 70-72 and 74-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649.

In regards to claims 66, 70, 74, 76 and 85-86: Iijima teaches a host (7) that operates in a first protocol; and a card (1) connectable to the host (7) for transferring data (data) and commands (command) between the card (1) and the host (7), wherein the card (1) is capable of operating in a plurality of communication protocols (Protocol A or Protocol B) including a first protocol (either A or B) and wherein the first protocol is selected in response to initialization (Reset) when connected to the host (7). Iijima teaches the card selecting the protocol based upon the masters informing it of which protocol to use. Iijima does not teach the card selecting the communication protocol without the master informing it which protocol to use. Official notice is taken that it is very well known for a device to select the communication protocol based upon the communication protocol of another device to which is to communicate. It would have been obvious to a person of ordinary skill in the art at the time of the invention for the memory card to select the protocol to use based upon the detected protocol of the master because this would have provided for backwards compatibility with older masters.

In regards to claims 67-68, 71-72 and 77-79: Iijima teaches a plurality of protocols. Iijima does not teach which specific protocols are supported. Official notice is taken that both

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the MultiMediaCard protocol and the Serial Peripheral Interface protocols are well known standard protocols. It would have been obvious to a person of ordinary skill in the art at the time of the invention to support these protocols because this would have made Iijima's card compliant to standards.

In regards to claim 75: Iijima teaches the master only communicating with one protocol.

In regards to claims 80 and 83-84: Iijima teaches a common bus for transferring command and data. Iijima does not expressly teach the use of a select signal from the master. The SPI protocol is well known and described above. The SPI protocol includes the select (CE), data-in (SDI), Data-out (SDO) and Clock (SCLK) lines. Thus with the SPI protocol the use of a select signal is required.

In regards to claim 81: Iijima teaches not needing a select signal. The MultiMediaCard protocol does not require a select signal.

In regards to claim 82: Iijima teaches the bus including command data and clock lines. The MultiMediaCard specification requires these signal lines.

6. Claims 69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649 in view of Mote, Jr. PN 5,852,617.

In regards to claims 69 and 73: Iijima teaches one bus for communication. Iijima does not teach a distinct bus for each of the plug-in cards. Mote teaches two separate busses one for standard parallel communication and one for serial JTAG (error handling protocol) communication. With one protocol being serial and the other being parallel. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use separate buses

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one for the serial protocol and one for the parallel protocol because this would have provided for dual communications.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PN 4,740,916 to Martin teaches the well known feature of a card select signal.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoleil can be reached on 703 305 9713. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703 308 9051 for regular communications and 703 308 9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

PRM
March 1, 2002

A handwritten signature in black ink, appearing to read "Paul R. Myers". The signature is fluid and cursive, with the first name "Paul" and last name "Myers" clearly distinguishable.

**PAUL R. MYERS
PRIMARY EXAMINER**